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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,829	03/29/2004	James A. Rogers	38-77(52900)F	3656

27161 7590 07/28/2006

MONSANTO COMPANY  
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ST. LOUIS, MO 63167

EXAMINER

ROBINSON, KEITH O NEAL

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/812,829

Applicant(s)

ROGERS ET AL.

Examiner

Keith O. Robinson, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 June 2006.  
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5, 10, 12, 13 and 21 is/are pending in the application.  
 4a) Of the above claim(s) 5 and 21 is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 10, 12 and 13 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date August 24, 2005.  
 4) ☐ Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) ☐ Notice of Informal Patent Application (PTO-152)  
 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group II (claims 10, 12 and 13) in the reply filed on June 2, 2006 is acknowledged. The traversal is on the ground(s) that the Examiner's restriction requirement is unduly divisive for the sake of simplifying prosecution at Applicant's expense. This is not found persuasive because the Examiner's reasons for restriction are due to the fact that Applicant has distinct inventions each distinct from the other and has nothing to do with "simplifying prosecution at Applicant's expense" as Applicant alleges. See CFR 1.142 where it states "If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division). Such requirement will normally be made before any action on the merits; however, it may be made at any time before final action". In the instant claims there are three (3) inventions as stated in the 'Requirement for Restriction' mailed May 3, 2006.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 5 and 21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on June 2, 2006.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102(b)***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 10, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldman et al (Crop Sci. 34: 908-915, 1994). The claims read on a method of breeding maize comprising selecting from a breeding population of maize plants a selected maize plant with higher oil than other maize plants in said breeding population based on allelic polymorphisms associated by linkage disequilibrium to a higher seed oil-related trait, wherein the selected maize plant has one or more higher oil alleles linked to a maize oil marker.

Goldman et al disclose a method of selecting maize plants from a breeding population of maize plants based on allelic polymorphisms associated by linkage disequilibrium to a higher seed oil-related trait (see page 909, 1<sup>st</sup> column, 2<sup>nd</sup> paragraph to page 910, 1<sup>st</sup> column, lines 1-6; page 910, 2<sup>nd</sup> column, 2<sup>nd</sup> full paragraph to page 913, 1<sup>st</sup> column, lines 1-16; and Table 1 on page 911).

5. Claims 10, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Berke et al (Crop Sci. 35: 1542-1549, 1995). The claims read on a method of breeding maize comprising selecting from a breeding population of maize plants a selected maize plant with higher oil than other maize plants in said breeding population based on allelic polymorphisms associated by linkage disequilibrium to a higher seed oil-related trait, wherein the selected maize plant has one or more higher oil alleles linked to a maize oil marker.

Berke et al disclose a method of selecting maize plants from a breeding population of maize plants based on allelic polymorphisms associated by linkage disequilibrium to a higher seed oil-related trait (see page 1542, 2<sup>nd</sup> column, 5<sup>th</sup> paragraph to page 1543, 2<sup>nd</sup> column, end of 3<sup>rd</sup> paragraph; page 1545, 2<sup>nd</sup> column, 1<sup>st</sup> and 2<sup>nd</sup> paragraphs; and page 1546, Table 3).

***Claim Rejections - 35 USC § 102(a)***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 10, 12 and 13 are rejected under 35 U.S.C. 102(a) as being anticipated by Song et al (Maydica 49: 41-48, 2004). The claims read on a method of breeding maize comprising selecting from a breeding population of maize plants a selected maize plant with higher oil than other maize plants in said breeding population based on allelic polymorphisms associated by linkage disequilibrium to a higher seed oil-related trait,

wherein the selected maize plant has one or more higher oil alleles linked to a maize oil marker.

Song et al disclose a method of selecting maize plants from a breeding population of maize plants based on allelic polymorphisms associated by linkage disequilibrium to a higher seed oil-related trait (see page 42, 1<sup>st</sup> column, 2<sup>nd</sup> paragraph to 2<sup>nd</sup> column, 1<sup>st</sup> and 2<sup>nd</sup> paragraphs; and page 43, 2<sup>nd</sup> column, 2<sup>nd</sup> paragraph and Figure 2 to page 44, 2<sup>nd</sup> column, lines 1-14).

### ***Conclusion***

8. No claims are allowed.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith O. Robinson, Ph.D. whose telephone number is 571-272-2918. The examiner can normally be reached on Monday - Friday 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Keith O. Robinson, Ph.D.

June 22, 2006

**DAVID H. KRUSE, PH.D.**  
**PRIMARY EXAMINER**

A handwritten signature in black ink, appearing to read "David H. Kruse", written in a cursive style.